IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

APPEAL FROM THE EXAMINER TO THE BOARD
OF PATENT APPEALS AND INTERFERENCES

In re Application of: Susann Marie Keohane	)	Confirmation No.: 8940
	)	
Serial No.: 10/666,816	)	Examiner: Dailey, Thomas J.
	)	
Filing Date: September 18, 2003	)	Group Art Unit: 2452
	)	
Title: A METHOD OF RESCINDING	)	Docket No.: AUS920030442US1
PREVIOUSLY TRANSMITTED E-MAIL	)	
MESSAGES	)	

MAIL STOP: APPEAL BRIEF-PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sir:

REPLY BRIEF

Appellants respectfully submit this Reply Brief in response to the Examiner's Answer mailed November 4, 2009, pursuant to 37 C.F.R. §41.41.

STATUS OF CLAIMS

Claims 1 and 3-10 stood rejected pursuant to a final Office Action mailed March 3, 2009 (hereinafter referred to as the "Final Office Action"). Claims 2 and 11-40 have been cancelled without prejudice or disclaimer. The Examiner withdrew the rejection of Claims 7-10 in the Examiner's Answer. Thus, Claims 1 and 3-6 are presented for appeal.

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

1.　　　Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Brogne* and *Nielsen* and in further view of *Milewski.*

2.　　　Claims 4-6 stand rejected under 35 U.S.C. 103(a) as allegedly being unpatentable over *Brogne* and *Nielsen* in view of *Milewski* as applied to claim 1 and further in view of what is alleged as being well known in the art.

ARGUMENT

1.   Rejection under 35 U.S.C. §103 in view of *Brogne, Nielsen and Milewski*

Claims 1 and 3 stand rejected under 35 U.S.C. §103(a) as allegedly being unpatentable in view of *Brogne, Nielsen* and *Milewski*. Appellant contends that Claims 1 and 3 are patentable over the cited *Brogne, Nielsen* and *Milewski* references. Of the rejected claims, Claim 1 is independent.

In the Examiner's Answer, the Examiner appears to assert that Appellant cannot attack references individually when the rejection is based on a combination of references (Examiner's Answer, page 10). Appellant respectfully points out that to establish a *prima facie* case of obviousness under 35 U.S.C. § 103, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, (Fed. Cir. 1991); M.P.E.P. § 2143. Clearly, Appellant is entitled to address each cited reference individually at least for the purpose of pointing out deficiencies in the cited references, for rebutting the Examiner's assertion of what a particular reference discloses, and especially to highlight that even when combined, the cited references share the same deficiencies.

Further, Claim 1 recites "generating a notification message . . . for allowing . . . the sender to access the stored e-mail message," sending the notification message to the . . . sender" and "enabling the sender, if one of the recipients from the list of recipients has accessed the stored e-mail message and **using the notification message**, to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message" (emphasis added). In the Examiner's Answer, the Examiner appears to rely on the purported teachings of *Milewski* for the "notification message" recited by Claim 1 (Examiner's Answer, pages 7, 10 and 11). Appellant respectfully submits that the purported teachings of *Milewski*, even if combined with *Brogne* and *Nielsen*, fail to disclose all of the features of Claim 1.

In *Milewski*, the "notification message" appears to be a "pointer" that points the sender to status information regarding a sent e-mail (*Milewski*, column 8, lines 61-64). The status information appears to be in the form of a "transaction summary form 600" that includes a response count and type of response to the sent e-mail, a list of recipients who have not yet responded to the sent e-mail, a field for sending a reminder to a recipient, and a

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field for deleting the sent e-mail message from the virtual mailbox of a controller (*Milewski*, column 8, lines 8-24). Thus, neither the pointer nor the transaction summary form of *Milewski* enables a sender to "access the stored e-mail message" as recited by Claim 1. Further, although the transaction summary form enables the sender to instruct the controller to delete the e-mail message from the controller (*Milewski*, column 8, lines 23-24, figure 6), the sender does not appear to be able to "access" the e-mail message.

Additionally, *Brogne* appears to teach that once one recipient has accessed the e-mail message, the e-mail message is automatically sent from the server to all remaining recipients, and the message is deleted from the server (*Brogne*, column 7, lines 41-52). *Nielsen* appears to teach that even if the e-mail message has been received by a recipient but not yet accessed, the sender may cancel the e-mail message by constructing another e-mail message that is sent to the recipient's e-mail system that causes the previously sent e-mail message to be deleted (*Nielsen*, column 4, lines 38-43). Thus, *arguendo*, even if the pointer or transaction summary form of *Milewski* is considered to be the "notification message" recited by Claim 1, according to the combined purported teachings of *Brogne* and *Nielsen*, once one of the recipients has accessed the stored e-mail message, the e-mail message is no longer stored on a server accessible by the sender. To the contrary, according to *Brogne* and *Nielsen*, any action to preclude one of the recipients that has not yet accessed the e-mail message from accessing the e-mail message would need to be performed at the recipient's e-mail system (e.g., sending another e-mail to the recipient's e-mail system according to *Nielsen*). However, none of the cited references appear to enable a sender of the e-mail to access a recipient's e-mail system to access the e-mail message. Thus, once one of the recipients has accessed the e-mail message, the cited references, even if combined, fail to disclose any "notification message" that enables the user to "access the stored e-mail message" and "preclude one of the recipients . . . that have not yet accessed the stored e-mail message from accessing the stored e-mail message" as recited by Claim 1.

Further, in the Examiner's Answer, the Examiner states that *Nielsen* teaches that the sender has access to the e-mail message even after it has been viewed by a recipient (Examiner's Answer, page 7 (relying on column 14, line 65 through column 15, line 15 of *Nielsen*)). Appellant respectfully disagrees. The referenced portion of *Nielsen* appears to be directed toward operations performed by the recipient's e-mail system if the recipient has already viewed the e-mail and the recipient has received a cancel message indicating that the

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sender has transmitted a "cancel" e-mail message. Thus, Appellant respectfully submits that the sender does not have access to the e-mail message as asserted by the Examiner.

Moreover, The Examiner appears to over-generalize the purported teachings of *Milewski* by asserting that the purported notification message of *Milewski* enables the sender "to perform operations on the stored message" (Examiner's Answer, page 7). However, arguendo, even if the pointer or transaction summary form of *Milewski* is considered to be the "notification message" recited by Claim 1, neither the pointer or transaction summary form of *Milewski* enables the sender to "access the stored e-mail message" as recited by Claim 1. To the contrary, although the sender may be able to send a subsequent cancel message to a recipient, Appellant respectfully submits that the subsequent cancel message does not provide the sender with "access [to] the stored e-mail message" as recited by Claim 1. Additionally, although the Examiner appears to rely on *Milewski* to allegedly teach that a sender may perform operations on the stored message, *Brogne* clearly teaches away from the sender being able to perform any operations on the sent e-mail once one of the recipients has accessed the sent e-mail.

Accordingly, for at least for the reasons discussed above, Appellant respectfully submits that Claim 1, and Claim 3 that depends therefrom, are patentable over the cited references.

2.   Rejection under 35 U.S.C. §103 in view of *Brogne, Nielsen* and *Milewski*

Claims 4-6 stand rejected under 35 U.S.C. 103(a) as being unpatentable over *Brogne* and *Nielsen* in view of *Milewski* as applied to claim 1 and further in view of what is alleged to be well known in the art.

Claims 4-6 depend from independent Claim 1. As indicated above, Appellant contends that Claim 1 is patentable over the *Brogne, Nielsen* and *Milewski* references. Therefore, for at least this reason, Claims 4-6 that depend from Claim 1 are also patentable.

CONCLUSION

Appellant has demonstrated that the present invention as claimed is clearly distinguishable over the art cited of record. Therefore, Appellant respectfully requests the Board of Patent Appeals and Interferences to reverse the final rejection of the Examiner.

No fee is believed due with this Reply Brief. If, however, Appellant has overlooked the need for any fee, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 09-0447 of IBM Corporation, referencing Attorney Docket No. AUS920030442US1.

Respectfully submitted,

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Date: **December 17, 2009**

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